

Appl. No.: 10/634,582
Amdt. dated 08/04/2005
Reply to Office action of 05/06/2005

REMARKS/ARGUMENTS

Applicants appreciate the thorough review of the application as evidenced by the Official Action. The Official Action rejects Claims 1-25 under 35 U.S.C. § 101 as being being directed to non-statutory subject matter. Claims 1-3, 7-10, 17-19, and 26-50 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,237,499 to Garback. In addition, Claims 4 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Garback, and Claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Garback in view of U.S. Patent No. 6,023,679 to Acebo et al. Finally, Claims 1-50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admission in view of *In re Venner*.

As explained below, independent Claims 1 and 26 have been amended. In light of the claim amendments and subsequent remarks, Applicants respectfully request reconsideration and allowance of the claims.

A. The rejection of Claims 1-25 under 35 U.S.C. § 101 is overcome

The Examiner finds that Claims 1-25, which are all directed to a method, are not within the technological arts. The Examiner believes that all of the steps of the claims could be performed by a person, which is allegedly admitted on page 2, lines 11-29 of the present application. Namely, the Examiner finds that the steps recited in Claims 1-25 are "old and well known, though complex," and could be performed by travel agents.

The Federal Circuit in *State Street Bank & Trust Co. v. Signature Financial* did not address the technological arts requirement that is purportedly part of a two-prong test for determining statutory subject matter. Instead, *State Street* held that statutory subject matter requires that a claimed process produces a useful, concrete, and tangible result. The Examiner does not contend that Claims 1-25 do not produce a useful, concrete, and tangible result.

Ex parte Bowman is an unpublished decision and non-binding precedent that addressed the interpretation of technological arts, holding that a claimed invention directed to a method for evaluating an intangible asset of interest did "not fall within the technological arts because no form of technology [was] disclosed or claimed." *Ex parte Bowman*, 61 U.S.P.Q.2d (BNA) 1669, 1671 (B. Patent App. & Int. 2001). Thus, the court looked to both the specification and the

Appl. No.: 10/634,582
Amdt. dated 08/04/2005
Reply to Office action of 05/06/2005

claims for any discussion of the use of technology. The court also held that the Examination Guidelines for Computer-Related Inventions (*MEPE* § 2106) were inapplicable “because there [was] no absolutely no indication on [the] record that the invention [was] connected to a computer in any manner.” *Id.* The court further held in *Ex parte Bowman* that merely transforming physical media into a chart and physically plotting a point on the chart, as recited in the claims, was not within the technological arts. Furthermore, the concurring judge stated that “a computer may arguably not be required to be disclosed,” and that arguments relating to “the use of any item or computer with which to practice or apply the claimed process beyond the abstraction of the human mind” are instructive in determining use or advancement of the technological arts. *Id.* at 1674.

Applicants respectfully disagree with the Examiner’s arguments, as both independent Claims 1 and 20 recite both “accessing a travel database” and “identifying at least one outbound and inbound itinerary between the destination location and each origin location from the travel database,” which are sufficient to demonstrate that the claims are within the technological arts. Furthermore, the specification of the present application is replete with references to a system including a client element, processing element, and database that are in communication with one another (See FIG. 1; pages 8-11). In particular, the specification discloses that:

The database 28 of the travel itinerary coordination system 20 may be part of one or more of the client element(s) 22, the server, and/or one or more of the processing element(s) 24, or most likely, may be separate from the client element(s) 22, the server, and the processing element(s) 24 and in communication with one or all of the elements via the Internet, intranet or other computer network(s) 30. Regardless of the configuration, the database 28 is accessed by other elements of the travel itinerary coordination system 20 via an interface, such as, but not limited to, a Common Object Request Broker Architecture (CORBA), active data object (ADO) interface or open database connectivity (ODBC) interface. Page 8, lines 19-27.

The database 28 may contain a variety of stored information, including the travel data, such as, but not limited to, schedules for one or more types of travel over a period of time, availability of the travel for each schedule, and pricing of the travel for each schedule. For example, in Figure 1, database 28 may be a global database system (GDS) or a computerized reservation system (CRS) as are known to those skilled in the art. Alternatively, the database may be an air travel database, such as an Air Travel Shopping Engine (ATSE), which contains a

Appl. No.: 10/634,582
Amdt. dated 08/04/2005
Reply to Office action of 05/06/2005

Scheduling Engine 48, an Availability Engine 50, and Pricing Engine 52. As used herein, the term itinerary is information that is returned from database 28, which includes schedule, availability and pricing information for a particular type of travel. The database may be any type of modern database, such as Sequel or Oracle. The data may be stored in tables in the database or in any other format known to those skilled in the art. Page 10, line 26 – page 11, line 6.

Ex parte Bowman requires that the specification and claims be read in conjunction with one another in order to determine whether the claimed invention is within the technological arts. Accordingly, Applicants submit that the travel database recited in Claims 1 and 26 and the specification of the present application adequately place the claimed invention within the technological arts. The travel database recited in Claims 1 and 26 is tied to the technological arts (e.g., client element(s), processing element(s), server, etc.) and is clearly distinguishable from the physical aspects at issue in *Ex parte Bowman*.

Moreover, the Examination Guidelines outlined in *MPEP* § 2106 are applicable because the claimed invention is at least related to a system that includes one more client and/or processing elements (e.g., computers). As explained in the Examination Guidelines, determining whether a claimed invention is directed to statutory subject matter under § 101 requires classifying the claims into one or more statutory or non-statutory categories. In this regard, statutory process claims are those that require one or more acts to be performed, where the claimed process results in a physical transformation outside a computer, or is limited to a practical application within the technological arts. *Id.* at Part IV.B.2.(b). The *MPEP* also reflects *State Street*'s decision by stating that the "purpose of this requirement is to limit patent protection that have a level of 'real world' value, as opposed to nothing more than an idea or concept." See *MPEP* §2106 II. A. In addition, the *MPEP* proffers a stringent requirement for asserting a lack of utility under §101. "Office personnel have the burden to establish a *prima facie* case that the claimed invention as whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of

Appl. No.: 10/634,582
Amdt. dated 08/04/2005
Reply to Office action of 05/06/2005

any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101,” (emphasis added). *See id.*

Applicants submit that Claims 1-25 recite a process that is not devoid of any limitation to a practical application in the technological arts and does possess real world value for coordinating outbound and inbound itineraries and determining suggested travel itineraries based upon an amount of time between traveling times between travelers associated with different origins. Therefore, it is evident that independent Claims 1 and 26, as well as the specification of the present application demonstrate that the claimed invention is within the technological arts and produce a useful, concrete, and tangible result. As such, the rejection of Claims 1-25 under 35 U.S.C. § 101 is overcome.

B. The rejection of independent Claims 1, 26, and 45 over Garback is overcome

The Examiner rejects independent Claims 1, 26, and 45 under 35 U.S.C. § 102(b) as being anticipated by Garback. Garback is directed to a computer travel planning system that is used to select travel itineraries that conform to individualized travel policies. More specifically, Garback discloses a system that automatically selects the lowest cost itineraries that conform to travel policies. In addition, the system employs a processor that accesses a tariff file, a traveler file, and a rule file, and has access to one or more CRS's for availability and booking. The tariff file includes airline schedules, routings, connecting times, and fares. The traveler file includes information such as corporate policies and personal profiles of travelers, while the rules file contains rules regarding fares for particular flights or itineraries. The processor utilizes the tariff file for determining appropriate flights and itineraries satisfying the traveler's request and communicates with the CRS to check availability. The process uses the tariff file to determine the lowest fares, as well as those itineraries satisfying the traveler's policy.

Applicants submit that independent Claims 1, 20, 26, and 45 are distinguishable over Garback. In particular, Garback does not disclose receiving an indication regarding a relative weight between price and schedule for at least some of the inbound and outbound itineraries, as recited by Claims 1 and 26. For example, a user can input “lowest available” or “unrestricted” to indicate the importance of price, while the user could also, or alternatively, input flexible or

Appl. No.: 10/634,582
Amdt. dated 08/04/2005
Reply to Office action of 05/06/2005

specific travel dates such that a relative weight is established between price and schedule (See FIG. 2; pages 12 and 13). Furthermore, the user can input an intermediate weighting between price and schedule if intermediate total waiting time and/or an intermediate total price is desired (See page 24).

In contrast, Garback only discloses that an individual group member inputs a travel request that includes an employee identification window, an individual venue or meeting code window, departure and destination city windows, departure and return date and time windows, a hotel request window, a car rental request window, special request window, a ticket delivery date window, and a verification window (See FIG. 3). Thus, there is simply no indication that users employing the system of Garback input a relative weight between price and schedule for inbound and outbound itineraries. Conversely, users employing the system of Garback are only capable of inputting departure and return dates/times, but there is no indication that the user inputs any indication regarding price in the travel request that is used to determine an itinerary.

Furthermore, independent Claim 1 has been amended to recite that the identified itineraries are labeled such that each of the identified outbound and inbound itineraries is associated with at least a price and schedule. A suggested outbound and inbound itinerary is determined from the labeled itineraries between the destination location and each origin location based upon the indication of the relative weight. Independent Claim 26 has been similarly amended in the context of a system. As described in the specification of the present application, groups of outbound and inbound itineraries are created using labels for each itinerary (See page 16). Labels are created for each arrival time of each of the itineraries associated with the same origin location. Each label contains at least an itinerary identifier, price, and waiting time between itineraries. The labels are populated into an outbound group matrix and an inbound group matrix, which may be searched by search engines to determine which group of itineraries best meets the relative weight between price and schedule indicated by each traveler.

As discussed above, Garback does not disclose receiving an indication regarding a relative weight between price and schedule for outbound and inbound itineraries. Garback also does not disclose labeling identified outbound and inbound itineraries, let alone determining a

Appl. No.: 10/634,582
Amdt. dated 08/04/2005
Reply to Office action of 05/06/2005

suggested outbound and inbound itinerary from the labeled itineraries based on the relative weight.

The Examiner does not address the specific recitations of independent Claims 20 and 45 in light of Garback. In any event, Garback does not teach or suggest determining the amount of time between the arrival times for at least one outbound itinerary associated with any two travelers, and/or the amount of time between the departing times for at least one inbound itinerary associated with any two travelers, and identifying at least one suggested outbound itinerary for each traveler based upon the amount of time between the arrival times of the respective traveler and at least one other traveler and/or at least one suggested inbound itinerary for each traveler based upon the amount of time between the departing times of the respective traveler and at least one other traveler, as recited by Claims 20 and 45. Conversely, Garback does not discuss determining the amount of time between arrival and/or departure times of two travelers at all, let alone identifying an outbound and/or inbound itinerary for each traveler based on the time differences.

Therefore, Applicants submit that the rejection of independent Claims 1, 26, and 45 under 35 U.S.C. § 102(b) is overcome. As such, Claims 1, 20, 26, and 45, and those claims that depend therefrom, are in condition for immediate allowance.

C. The rejection of independent Claims 1, 20, 26, and 45 over Applicants' admission in view of *In re Venner* is overcome

The Examiner rejects Claims 1-50 under 35 U.S.C. § 103(a) over the Applicants' admission and *In re Venner* regarding the automation of a known manual process. Applicants submit that the rejection of independent Claims 20 and 45 do not necessitate amendments to overcome the rejection, as the claims recite determining an amount of time between arrival and/or departure times for travelers and using the time to identify outbound and/or inbound itineraries, which is nowhere taught or suggested in the background of the present application. At most, the background of the present application only generally describes a travel agent that

Appl. No.: 10/634,582
Amdt. dated 08/04/2005
Reply to Office action of 05/06/2005

evaluates itineraries to determine which itineraries meet scheduling requirements, which simply does not disclose the level of detail recited in independent Claims 20 and 45.

However, independent Claims 1 and 26 have been amended. As described above, Claims 1 and 26 now recite that the identified itineraries are labeled such that each of the identified outbound and inbound itineraries is associated with at least a price and schedule. Using the labeled itineraries, suggested outbound and inbound itineraries are determined based upon the indication of relative weight between price and schedule for the outbound and inbound itineraries. Applicants submit that the background of the present application nowhere discloses labeling itineraries that were identified from a travel database and then using the labeled itineraries to determine suggested outbound and inbound itineraries based upon the relative weight.

Therefore, Applicants submit that the rejection of Claims 1-50 under 35 U.S.C. § 103(a) over Applicant's admission in view of *In re Venner* is overcome and respectfully request reconsideration of the claims.

Appl. No.: 10/634,582
Amtd. dated 08/04/2005
Reply to Office action of 05/06/2005

CONCLUSION

In view of the amendments and remarks presented above, it is respectfully submitted that all of the present claims of the present application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

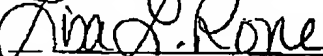


Trent A. Kirk
Registration No. 54,223

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at Fax No. (703) 872-9806 on the date shown below.



Lisa L. Rone

8/4/05

Date